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REPLY BRIEF

Applicant : NAKAMORI, et al.

App. No : 10/536,621

Filed : May 26, 2005

For : POLISHING PAD AND METHOD OF
PRODUCING SEMICONDUCTOR
DEVICE

Examiner : Sylvia Macarthur

Art Unit : 1716

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's answer mailed February 2, 2011, which was sent in response to the Appeal Brief, filed by Applicant on November 15, 2010, in accordance with the Notice of Appeal, filed September 13, 2010.

TABLE OF CONTENTS

I. STATUS OF CLAIMS	3
II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	4
III. ARGUMENT	5
IV. CONCLUSION.....	7

Docket No.: UNIU40.005APC
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I. STATUS OF CLAIMS

Claims 1-4, 7, 13, and 15-22 are pending in the application. Claims 5, 6, 8-12, and 14 have been canceled. Claims 22 have been withdrawn requesting rejoinder. Claims 1-4, 7, 13, and 15-21 all stand rejected, and are the subject of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejections of Claims 1-4, 7, 13, and 15-21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ishikawa et al. U.S. Publication Number 2002/0042243 in view of Shimomura et al. Japanese publication 2002-275933.

III. ARGUMENT

Rejection for Claims 1-4, 7, 13, and 15-21 under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa et al and Shimomura et al

The Examiner has withdrawn rejections for Claims 1, 7, 13, and 15-21 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi et al in view of Halley, and Claims 1, 4, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Toru in view of Halley and Shimomura et al.

However, the Examiner has maintained the rejection for Claims 1-4, 7, 13, and 15-21 under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa et al and Shimomura et al. The Appellant respectfully disagrees with the Examiner's previous rejection and the comments contained in the Examiner's Answer of February 2, 2011.

The Appellant continues to present arguments presented in the Appeal Brief filed on November 15, 2010. In particular, Ishikawa does not disclose the claimed wave length ranges in connection with light transmittance, and Ishikawa's teaching of a transmissivity range 22% or greater is not associated with the any particular wave length light transmittance. Further, Ishikawa fails to recognize the criticality of the cited range which demonstrated by the evaluation results in the present specification.

The Examiner acknowledged that Ishikawa is silent as to the wavelength range used to evaluate light transmittance. However the Examiner took the position that it would be obvious to try to use the same wavelength range used to determine the transmittance and transmissivity as already used within the apparatus with a reasonable expectation of success, since reflective spectrum and transmittance are properties that are determined along a wavelength range. However, the rationale for such a rejection is dependent on obtaining no more that predictable results. In the present case, the completely unexpected results reported in Table 1 are obtained. In particular, when light transmittance in the recited ranges are employed unexpectedly high reproducibility is obtained compared to use of light transmittance outside the claimed ranges.

Moreover, Appellant respectfully submits that to reject a claim based on the limitations of the claim being obvious to try, the Examiner must articulate findings that at the time of the invention "a recognized problem or need in the art" existed, "a finite number of identified, predictable potential solutions" existed, and "one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success." See Examination

Guidelines for Determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex, 72 Fed. Reg. 57,526, 57,532 (October 10, 2007).

Appellant respectfully submits that Examiner does not articulate a finding that there had been a recognized problem or need in the art at the time of the invention, nor a finite number of identified, predictable potential solutions existed. According to the presently claimed invention, a certain transmissivity is associated with the narrow ranges of wavelengths (i.e., 400 to 700 nm, or 600 to 700 nm), while Ishikawa teaches to apply a single transmissivity to entire wavelengths of visible light. See paragraph [0053] and Figure 12 of Ishikawa. Thus, Ishikawa does not recognize this instant feature as a result effective variable and its criticality, consequently does not recognize need to associate a certain transmissivity with the narrow range of wave lengths at the time of the claimed invention.

With respect to “a finite number of identified, predictable potential solutions”, Ishikawa merely states a wide range of wavelength 400~800 (nm) and transmissivity 22% or more. One having ordinary skill in the art could in no way derive the claimed invention from only the cited reference as there are indefinite numbers of combination for the wavelength range and transmissivity.

Further, the Examiner states that Ishikawa recites a transmissivity 89%. Ishikawa does disclose in Example 1-1 that the transmittance to both window and the slurry is 89%. However, the window is made of an acrylic resin and not of a polyurethane resin used in the present invention, and the isolated value of 89% is not associated with any particular range of the wavelength. The other cited reference Shimomura does not cure the noted differences in Ishikawa. Therefore, no prima facie case of obviousness is established. Moreover, the Examiner entirely ignored the evidence of criticality of the recited range described in Table 1 of the present invention.

Additionally, in rejecting the claims, the Examiner concluded obviousness without any supporting evidence. The Examiner asserted on page 4 of Examiner’s Answer that “it would have been obvious...to try and use the same wavelength range” as described in Ishikawa. However, Appellant’s claims do not recite this same wavelength. Rather, the range 400 to 700 nm and 600 to 700 nm are recited. Each of these wavelength ranges is associated with a particular light transmittance that is nowhere described in the cited reference.

IV. CONCLUSION

For at least the reasons explained above, Appellant respectfully submits that the rejections of Claims 1-4, 13, and 15-21 are improper and should be reversed.

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Dated: April 1, 2011

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